

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-9, 11-35, 37-41, and 43-48 are currently pending. Claims 1, 5, 7, 9, 11, 32-35, 37-41, 43, and 47, which are independent, are hereby amended. Support for this amendment is provided throughout the Specification.

No new matter has been introduced. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. §101 and 102(b)**

Claims 1, 5, 7, 9, 11, 32-41, and 43 were objected to because of informalities.

Claims 1-9, 11-35, 37-41, and 43-48 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

Claims 1-9, 11-35, 37-41, and 43-48 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,144,969 to Inokuchi et al. (hereinafter, merely "Inokuchi").

### III. RESPONSE TO REJECTIONS

#### A. Response to Objections

Claims 1, 5, 7, 9, 11, 32-35, 36-41, 43, and 47 are amended, thereby obviating the objections.

#### B. Response to Rejections Under 35 U.S.C. §101

Applicants respectfully traverse the 35 U.S.C. § 101 rejection. Applicants submit that claims 1, 5, 7, 9, 11, 39-41, and 43 are directed to “apparatus” and elements are in mean-plus-function form. Applicants submit that apparatus is a statutory subject matter under 35 U.S.C. §101. Applicants further submit that Court Appeals of Federal Circuit (CAFC) holds that “means” can read on software instrumentation. Applicants respectfully submit that claim 38 is directed to “apparatus” that is a statutory subject matter.

Withdrawal of the Rejections Under 35 U.S.C. §101 is requested.

#### C. Response to Rejection Under 35 U.S.C. §102(b)

Claim 1 recites, *inter alia*:

“A recording apparatus for recording desired files on a recording medium, comprising:

**index file generation means for generating an index file of the files recorded on the recording medium, said index file having a series of entries each being a block of extract information relating to and coordinated with one of the files recorded on the recording medium,**” (Emphasis added)

As understood by Applicants, Inokuchi relates to file name conversion method and apparatus for converting a first file name that can be distinguished by a given operating system into a second file name that can be distinguished both by the given operating system and other operating systems. The method and apparatus insure that the first and second file names

do not already exist on an associated recording medium prior to recording the first file name on the recording medium and prior to converting the first file name to the second file name.

Claim 1 is directed to the structure of index file of a plurality of files recorded on a recording medium that improves the operability of the index file. Independent claims 5, 7, 9, 11, 32-35, 36-41, 43, and 47 also recite similar features.

The Office Action (see page 5) relies on column 5, lines 42-45, Figure 1, 3, 4, and 11 of Inokuchi to reject index file generation means for generating an index file of the files recorded on the recording medium, said index file having a series of entries each being a block of extract information relating to and coordinated with one of the files recorded on the recording medium, as recited in claim 1 (emphasis added). Applicants respectfully submit that the Office Action incorrectly interprets Inokuchi because Figure 1, 3, 4 and 11 of Inokuchi describe structure of the content file itself corresponding to one file recorded on recording medium but NOT the structure of the index file, as recited in claim 1. Applicants respectfully submit that Inokuchi fails to disclose or teach the above-identified features of claim 1.

Therefore, Applicants submit that independent claim 1 is patentable.

For reasons similar to those described above with regard to independent claims 5, 7, 9, 11, 32-35, 36-41, 43, and 47 are also patentable.

#### **IV. DEPENDENT CLAIMS**

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

**CONCLUSION**


In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference or references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that claim 4 is patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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